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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,703	07/17/2003	Yoshitaka Sakoh	02410335AA	9315
30743 7590 06/07/2010 WHITHAM, CURTIS & CHRISTOFFERSON & COOK, P.C. 11491 SUNSET HILLS ROAD SUITE 340 RESTON, VA 20190				
EXAMINER RENWICK, REGINALD A				
ART UNIT		PAPER NUMBER		
3714				
MAIL DATE		DELIVERY MODE		
06/07/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/620,703

**Applicant(s)**

SAKOH, YOSHITAKA

**Examiner**

REGINALD A. RENWICK

**Art Unit**

3714

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 5-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12 and 13 is/are allowed.
- 6) ☒ Claim(s) 1 and 5-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### **DETAILED ACTION**

1. In response to the Amendment filed on September 8<sup>th</sup>, 2009; claims 2-4 had been cancelled and claims 1 and 5-13 are pending.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

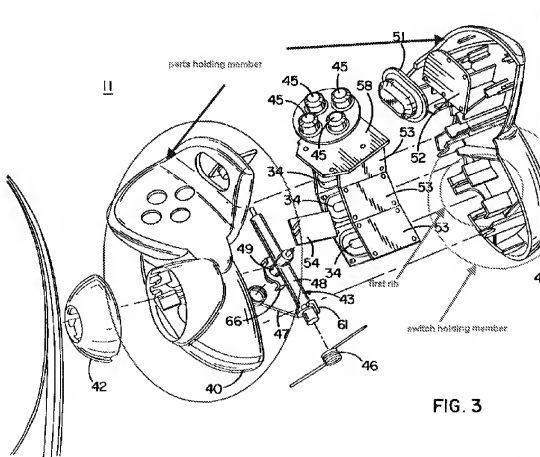
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Cook (US Pat. No. 6,198,471 B1).

Re claim 1 and 6: The broadly claimed structure can be interpreted as the controller of Cook. Cook broadly discloses a controller (100) comprising: a main board, on which an electrical component is mounted and extending in a first direction (Fig. 2: item 38; column 6, lines 1-7); a switch board, provided so as to extend in a second direction perpendicular to the first direction (Fig. 3: item 53; column 5, lines 37-50); a push switch, mounted on the switch board and electrically connected to the electronic component, the push switch adapted to be pushed in the first direction (Fig. 4: item 34; column 5, lines 37-50); a parts holding member, interposed between the switch board and the main board so that the switch board is perpendicularly provided on the main board and adapted to receive a stress generated when the push switch is pushed (Fig. 1: items 11, 12, 105, 110; column 5, lines 3-5)(i.e. the switch board 53 can be on the

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main board by being connect to it through wiring, similarly to how one can be on an object by merely using their hand and not their entire body. Switch button 34 activates printed circuit board 53, which sends signals through wiring to main board 38 to cord 13 to the information processing device. This is also similar to the common phrase "hang the picture on the wall". Although the picture may not be directly attached to the wall, it is still on the wall. Therefore, the switch board of Cook is still on the main board); and a board holder portion, holding the switch board and integrally formed with the parts holding member (Fig. 2: item 33, Fig. 3: item 41; column 4, lines 59 and 60 as discussed in claim 6).



Re claims 8-10: Cook discloses that the controller further comprises a first rib (see above figure) formed on the board holder portion so as to receive a force generated by an operation of the push switch (as is shown above since the ribs hold the board holder portion in position as shown in figure 5c). As is also shown, the first rib is in contact with the parts holding member, and is formed with the parts holding member.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 5, 7, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook (US Pat. No. 6,198,471 B1) in view of Tickle (US Pat. No. 5,670,988).

Re claims 5, 7, and 11: Although, Cook discloses a power source for the controller (column 4, lines 63-66), Cook fails to disclose that the controller comprises of

a battery terminal holding member, holding a battery terminal and integrally formed with the parts holding member. However, Tickle discloses a game controller with a battery terminal that is monolithically formed with the parts holding members and contains ribs for containing the battery. Furthermore, Tickle discloses the use of a wireless module that is formed within the controller. It is reasonable for one skilled in the art to adapt the controller of Cook to incorporate the battery terminal and wireless module of Tickle into the controller figuration, as all that is needed by the controller is ample space, which Cook has within the parts holder members 105 and 110. Because Cook discloses that the controller uses a power chord to receive power, it would have been obvious to one skilled in the art at the time the invention was made to modify Cook with the battery terminal and the wireless module of Tickle, for the purpose of making the controller of Cook portable MPEP 2144.04.

***Allowable Subject Matter***

6. Claims 12 and 13 are allowed.

***Response to Arguments***

7. Applicant's arguments filed September 8, 2009 have been fully considered but they are not persuasive. Applicant has amended the claim language of claim 1 to state that "a parts holding member interposed between the switch board and the main board so that the switch board is perpendicularly provided on the main board..." However, the claim language does not state where on the main board is the switch board, or how it is

on the main board. The switch board (object 53), can be on the main board by being connect to it through wiring), similarly to how one can be on an object by merely using their hand and not their entire body. Switch button 34 activates printed circuit board 53, which sends signals through wiring (not shown) to main board 38 to cord 13 to the information processing device. This is also similar to the common phrase "hang the picture on the wall." Although the picture may not be directly attached to the wall, it is still on the wall. Therefore, the switch board (object 53) of Cook is still on the main board.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to REGINALD A. RENWICK whose telephone number is (571)270-1913. The examiner can normally be reached on Monday-Friday, 7:30AM-5:00PM, Alt Fridays, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on 571-272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. A. R./  
Examiner, Art Unit 3714

/Pierre E. Elisca/  
Primary Examiner, Art Unit 3714